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FEB 09 2005

OFFICE OF PETITIONS

Applicant: Duft et al.
Appl. No.: 09/445,517
Filed: December 6, 1999
Title: METHODS FOR TREATING OBESITY
Attorney Docket No.: 18528.230/235/013 US
Pub. No.: US 2004/0022807 A1
Pub. Date: February 5, 2004

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on April 5, 2004 for the above-identified application.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains an error on the front page of the publication in the "Related U.S. Application Data," as the application No. 08/870,762 is listed as a "provisional" application and it should state be listed as a "continuation-in-part".

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹ The instant request does not identify a material mistake in the publication made by the Office:

The error in the continuity claim on the front page of the publication is an Office mistake, but it is not a material mistake as required by 37 CFR 1.221(b). The error on the front page is clearly a typographical error as the application number listed is a nonprovisional application number and not a provisional application number. Furthermore, the benefit claim (as required by 37 CFR 1.78) in the first line of the specification states that it is a "continuation-in-part," not a "provisional application" The improper priority claim is not a material mistake because it does not affect the public's ability to appreciate the technical disclosure of the patent application

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. Since, the first line of the specification contains the proper benefit claim, one can read and understand the content of the application and properly use the patent application publication as a prior art reference.

On March 29, 2001 a Filing Receipt was mailed, which did not properly list the priority information. To avoid this type of problem in the future, applicant's representative should make request a corrected filing receipt.

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

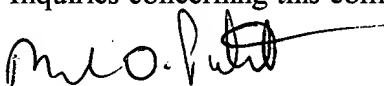
Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system and questions should be addressed as follows:

By mail to: Mail Stop PGPUB
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: 703-872-9306

The application will be examined in due course.

Inquiries concerning this communication should be directed to Mark Polutta at (571) 272-7709.



Mark O. Polutta
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Corrected Filing Receipt